

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

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WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:
JOHN C. TODARO
MERCK & CO., INC.
126 EAST LINCOLN AVENUE
RAHWAY, NJ 07065-0907

Date of mailing
(day/month/year)

21 JUN 2005

Applicant's or agent's file reference

PCT 21664Y

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/US05/10224

International filing date (day/month/year)

25 March 2005 (25.03.2005)

Priority date (day/month/year)

30 March 2004 (30.03.2004)

International Patent Classification (IPC) or both national classification and IPC

IPC(7): C07D 277/60 and US Cl.: 548/150

Applicant

MERCK & CO., INC.

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☒ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later. ✓

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/ US

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Commissioner for Patents
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Authorized officer

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**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/US05/10224

Box No. I Basis of this opinion

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).

2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

☐ a sequence listing

☐ table(s) related to the sequence listing

b. format of material

☐ in written format

☐ in computer readable form

c. time of filing/furnishing

☐ contained in international application as filed.

☐ filed together with the international application in computer readable form.

☐ furnished subsequently to this Authority for the purposes of search.

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/US05/10224

Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been examined in respect of:

☐ the entire international application

☒ claims Nos. 1-16 and 18-23

because:

☐ the said international application, or the said claim Nos. _____ relate to the following subject matter which does not require an international preliminary examination (*specify*):

☒ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. 1-16 and 18-23 are so unclear that no meaningful opinion could be formed (*specify*):

In these claims, numerous variables {e.g., R¹, R³, R⁴ etc.}, their voluminous involved meanings, their large number of permutations and combinations and the list of compounds in claims 17 and 18 make it virtually impossible to determine the full scope for which protection is sought. As presented, the claimed subject matter cannot be regarded as being a concise description for which protection is sought and as such, the claims do not comply with the requirements of PCT Article 6. Thus, it is impossible to carry out a meaningful timely search on same. A search will be provided on the first discernable invention, which is the first compound listed in claim 17.

☐ the claims, or said claims Nos. _____ are so inadequately supported by the description that no meaningful opinion could be formed.

☐ no international search report has been established for said claims Nos. _____

☐ the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:

the written form

☐

has not been furnished

☐

does not comply with the standard

the computer readable form

☐

has not been furnished

☐

does not comply with the standard

☐ the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-bis of the Administrative Instructions.

☐ See Supplemental Box for further details.

WRITTEN OPINION OF THE
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International application No.
PCT/US05/10224

Box No. V Reasoned statement under Rule 43 bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims <u>NONE</u>	YES
	Claims <u>17 (in-part)</u>	NO
Inventive step (IS)	Claims <u>NONE</u>	YES
	Claims <u>17 (in-part)</u>	NO
Industrial applicability (IA)	Claims <u>17 (in-part)</u>	YES
	Claims <u>NONE</u>	NO

2. Citations and explanations:

Claim 17 (in-part) lacks novelty under PCT Article 33(2) as being anticipated by Arya et al. {Indian Journal of Chemistry (August 1972), 10(8), pages 815-819}.

Arya et al. disclose Compound VIII on page 815, which is the same as the first compound listed in instant claim 17. Therefore, claim 17 (in-part) lacks novelty.